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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/313,625	05/18/1999	GARY D. HODGEN	P/1890-200(D	4150

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EXAMINER

WEBMAN, EDWARD J

ART UNIT PAPER NUMBER

1616

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/313,625
Filing Date: May 18, 1999
Appellant(s): HODGEN, GARY D.

E. A. Meilman
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 1/23/06 appealing from the Office action
mailed 6/10/04.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

Applicants state there are no related appeals, interferences, or judicial proceedings.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,729,999	YOUNG	3-1988
5,116,865	PETERS	5-1992

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 10, 12, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Young et al in view of Peters et al

Young et al teach anti-estrogens for treating estrogen deficiency (abstract). Clomiphene is specified (example 1).

Applicants disclose that it is known in the art that selective estrogen receptor modulators (SERMs) raise estrogen levels, which are responsible for the side effect of uterine bleeding (pages 1-3).

Peters et al teach that is is also known in the art to use levonorgestrel to control uterine bleeding (column 1 lines 37-53).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add levonorgestrel to the treatment of Young et al to achieve the beneficial effect of controlling uterine bleeding in view of Peters et al.

(10) Response to Argument

Applicant argues that Peters et al does not teach control of SERM induced bleeding when a SERM is used for hormone replacement therapy (HRT), therefore, there is no motivation to combine. Applicant notes in his argument, that his claims are written in Jepson format, because treatment of HRT with a SERM such as clomiphene is known in the art, the claimed improvement being the addition of an agent with progestogenic activity such as levonorgestrel to.

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modulate bleeding side effects associated with the SERM. That is, it is the addition of levonorgestrel in conjunction with clomiphene to treat bleeding during HRT which is asserted as novel. However, applicant's specification discloses that it is unknown in the art that estrogen therapy, that is HRT, induces uterine bleeding and that anti-estrogens such as clomiphene cause the production of endogenous estrogens (pages 2 and 3). That is, clomiphene used in HRT engenders uterine bleeding. Thus, it would be obvious to one of ordinary skill to add a compound which will control such bleeding, irrespective of a nexus to SERM treatment of HRT. In fact, if such a nexus was present in Peters et al, applicant would face a rejection under 35 USC 102b. Thus, the argument that Peters et al does not teach control bleeding in the context SERM treatment of HRT is not persuasive.


(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

E. Webman



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